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In the UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Detkef Fischer

Application No. 10/763,786

Attorney Docket No. 2001P13794WOUS

Filed: January 23, 2004

Title: PROCESS CONTROL SYSTEM WITH A CHARGING FUNCTION

Examiner: Sunray Chang

Art Unit: 2121

⇒ **FACSIMILE ATTN TO: SUNRAY CHANG**

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RESPONSE TO FINAL OFFICE ACTION

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TRANSMITTAL FORM	Application Number	10/763,786
	Filing Date	January 23, 2004
	First Named Inventor	Detkef Fischer
	Art Unit	2121
	Examiner Name	Sunray Chang
(to be used for all correspondence after initial filing)		
Total Number of Pages in This Submission	6	Attorney Docket Number
		2001P13794WOUS

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PATENT
Attorney Docket No. 2001P13794WOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventor: D. Fischer et al.

Serial No.: 10/763,786

Filed: January 23, 2004

)
) Group Art Unit: 2121

)
) Examiner: Chang, Sunray

Title: **PROCESS CONTROL SYSTEM WITH A CHARGING FUNCTION**

MAIL STOP AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE UNDER 37 C.F.R. 1.116

This paper is in response to the Final Office Action mailed August 29, 2006.

Reconsideration of the application in view of the following Remarks is respectfully requested.

Claims 1 - 14 are pending in this application. Claims 1, 3, 5, 7 and 9 - 14 have been finally rejected under Section 102 based on U.S. application 20040204775 (herein referred to as the Keyes reference). Claims 2, 4, 6 and 8 have been finally rejected under Section 103 based on Keyes in view of 200310144746 (herein referred to as the Hsuing reference).

This response restates and clarifies the reasons why the subject matter relied upon for the final rejection is not prior art under the law. Accordingly, none of the rejections is supported by the art and all must be withdrawn. The rejections were incorrectly premised on belief that the

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US Provisional Application 60/273,164 (the '164 application) can be used to establish a prior art date of March 1, 2001 for the Keyes reference.

It is also argued herein that the subject matter present in the Keyes reference, upon which the final rejection is based, is not the same as what applicants present in the claims and, therefore, does not support a rejection under Section 102.

Reconsideration is requested for these specific reasons now discussed more fully below.

I. Application '164 Cannot Form a Valid Basis For Defining the Keyes Reference as Prior Art

The Keyes reference is a CIP of 09/953,811 (published as US2002/0077711), which in turn claimed the benefit of the '164 application. However, in order for the Keyes reference to be accorded the filing date of the '164 application as an effective prior art date for the purpose of rejecting the present claims, each application in the chain of applications extending back from Keyes to the provisional '164 application must either expressly disclose the same subject matter relied upon to reject the applicants' claims, or must have expressly incorporated by reference the same subject matter. Subject matter disclosed in the '164 application (the grandparent of Keyes) but not included in 09/953,811 (the parent of Keyes), cannot be relied upon in a Section 102(e) rejection based on the child application (i.e., the Keyes reference). In this instance, the continuation chain was broken because the parent 09/953,811 application in the chain of applications does not recite or incorporate by reference the subject matter which is relied upon for the rejection. Absence of the requisite disclosure in 09/953,811 breaks the continuity of the subject matter which must be present in order to accord the Keyes reference a prior art date of March 1, 2001.

Furthermore, the Keyes reference could not have been entitled to the benefit of the earlier filing date accorded the provisional application '164 because there is no continuity of inventorship from the '164 application to Keyes. Under 35 USC 119(e)(1) the Keyes reference obtains benefit of the filing date of the provisional application '164 only if at least one inventor is named in all three applications in the chain. See, also, 35 USC 120 which states that an application filed by an inventor named in a previously filed and copending US application will have the same effect as to the invention as though filed on the date of the prior application. Here, none of the inventors named in the Keyes reference are among the three inventors named

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in the '164 application, and therefore, the Keyes reference is not accorded the provisional application date for either priority or for prior art purposes.

As explained in MPEP 2163.03, in order to carry back a 102(e) critical date to the filing date of the parent application, there must be a right to the earlier date under 35 USC 119 or 35 USC 120 and the prior application must support the claimed invention as required by Section 112. In this case, the parent application to the Keyes reference is the 09/953,811 application filed Sept. 17, 2001, which does not support the subject matter which the Examiner seeks to rely upon. With regard to deficiencies present in the this chain of priority see, specifically, MPEP 2136.03 (d) which states:

“In order to carry back the 35 USC 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the US patent reference must have a right of priority to the earlier date under 35 USC 120 ... and the parent application must support the invention claimed as required by 35 USC 112, first paragraph.”

See, also, example 2 in MPEP 706.02(f)(1) which notes that the earlier filed application must have proper support for the subject matter under Section 119(e) or Section 120.

In summary, there are two deficiencies which preclude qualification of the Keyes reference as prior art: 1) the intervening parent 09/953,811 application does not support applicants' claimed subject matter under Section 112; and the provisional application '164 does not include any common inventorship with the Keyes reference.

II. Even If the Provisional Application '164 Was Prior Art, It Could Not Form a Valid Basis For Rejecting the Claims Under Section 102

Finally, it is submitted that neither the Keyes reference nor the provisional application '164 disclose or suggest the subject matter of the rejected independent claims. Claim 1 expressly requires “a processor unit adapted to determine a payment figure” and claim 14 expressly requires “determining a payment figure by the processor unit ...” In contrast, the Keyes reference only discloses that “a service provider could, for a fee, provide a service ...” [see page

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16, par. 0114, line 5] and that "[of] course, the service provider may charge a fee for any or all of collecting the data, running the computer model ... [see page 16, par. 0114, lines 27-32]"

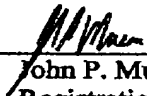
The Keyes reference does not disclose the combinations set forth in claims 1 and 14. There is no basis to sustain a rejection under Section 102.

Conclusion

For the foregoing reasons, it is respectfully submitted that the use of the Keyes reference to reject Applicant's claims is misplaced and that all of the rejections under Section 102 and 103 lack support in the art. Accordingly, Applicants respectfully request that the Examiner reconsider the application, withdraw the rejections and timely pass the application to allowance. Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 10/3/06

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